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EXAMINER


BUI, KIM T

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/780,221	Applicant(s) ROBIBERO, KENNETH	
	Examiner Kim T. Bui	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8,10-14 and 18-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The body of the claim(s) must recite how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

- (A) In the present case, claims 1-8,10-14 and 18-24 recite an abstract idea only.

The recited steps of the claims are merely for receiving, converting, checking medical prescription and generating alert signal do not involve, use, or advance the

technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a method for comparing converting and checking medical prescription (i.e., repeatable) used in medical prescription system (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-8, 10-14 and 18-24 deemed to be directed to non-statutory subject matter.

Regarding claim 35, it is presumed that the step "automatically converting" is performed using a computer.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claims 1, 14, the preamble of the claims recite "electronic prescription handling system" and "data handling and transfer system". However there is no structure in the body of the claims to support the recitation of "the system"

Dependent claims 2-13, 15-24 incorporate the deficiencies of the claims they

depend on and are therefore rejected.

Claim Rejections - 35 USC § 103

5. Claims 1-3, 5-18, 20-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al. (5737539) in view of Pham et al. (5524253).

(A) As per claim 1, Edelson et al. teaches a prescription creation system comprising;

a. interface for receiving data from application program including electronic prescription generating program. Edelson et al. Fig. 16, col 4, lines 60 to col. 6, line 28, col. 45, lines 15-68.

b. prescription analyzer for checking medical prescription for potential drug interaction. Edelson et al., ... Fig. 16, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38.,

c. alert signal generator for generating alert signal upon detection of drug interaction. Edelson et al., Fig. 16, col. 30, lines 61-65, col. 31, lines 38-43, col. 32, lines 48-60.

Edelson fails to teach fails to teach the code translator for converting data block from a respective format to common format. This, however, is well known as evidenced by Pham et al. Pham et al. discloses a system for integrating application programs including a code translator for converting data into a common formatting convention. Pham et al., col. 16, lines 34-56, col. 17, line 49 to col. 19, line 15. It would have been obvious to one having ordinary skill in the art at the time of the invention to include common data converting technique into the computer network disclosed by Edelson

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with the motivation of improving interprocess-communication between the computers in the network due to data incompatibilities. Pham et al., col. 1, lines 15-22.

(B) As per claim 14, Edelson et al. teaches a prescription creation system comprising;

a. interface for receiving data from application program including electronic prescription generating program. Edelson et al. Fig. 16, col. 4, lines 60 to col. 6, line 28, col. 45, lines 15-68, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38, col. 30, lines 61-65, col. 31, lines 38-43, col. 32, lines 48-60, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38,

Edelson fails to expressly recite the code translator, but suggests the code translator(i.e. marshalling) on col. 7, lines 23-25. In addition , Pham et al. discloses a system for integrating application programs including a first and second code translators for converting data into a common formatting convention and for converting data from common formatting convention to target software formatting convention, wherein the first code translator including data field detection and definition module. Pham et al., col. 16, lines 34-56, col. 17, line 49 to col. 20, line 16, col. 10, line 33 to col. 11, line 50. It would have been obvious to one having ordinary skill in the art at the time of the invention to include first and second (i.e. marshalling and unmarshalling) code translators into the computer network disclosed by Edelson with the motivation of improving interprocess-communication between the computers in the network due to data incompatibilities. Pham et al., col. 1, lines 15-22.

(C) As per claim 25, Edelson et al. teaches a medical risk control method comprising;

a. interface for receiving data from application programs including electronic prescription generating program, prescription analyzer for checking medical prescription for drug interaction. Edelson et al. Fig. 16, col. 4, lines 60 to col. 6, line 28, col. 45, lines 15-68, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38, col. 30, lines 61-65, col. 31, lines 38-43, col. 32, lines 48-60, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38,

Edelson fails to expressly recite the code translator, but suggests the code translator(i.e. marshalling) on col. 7, lines 23-25. In addition, Pham et al teach system for integrating application programs including the first code translator for converting data block from a respective format to common format and to transmitting data to respective target applications. Pham et al., col. 16, lines 34-56, col. 17, line 49 to col. 20, line 16, col. 10, line 33 to col. 11, line 50. It would have been obvious to one having ordinary skill in the art at the time of the invention to include first and second (i.e. marshalling and unmarshalling) code translators into the computer network disclosed by Edelson with the motivation of improving interprocess-communication between the computers in the network due to data incompatibilities. Pham et al., col. 1, lines 15-22.

(D) As per claim 35, Edelson et al. teaches a data handling and transfer method for generating electronic prescription comprising:

a. interface for receiving data from application program including electronic prescription generating program for analyzing medical prescription for drug interaction.

Edelson et al., Fig. 16, col. 30, lines. Edelson et al. Fig. 16, col. 4, lines 60 to col. 6, line 28, col. 45, lines 15-68, col. 30, line 64 to col. 31, line 38, col. 30, lines 61-65, col. 31, lines 38-43, col. 32, lines 48-60, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38,

Edelson fails to expressly recite the code translator, but suggests the code translator (i.e. marshalling) on col. 7, lines 23-25. In addition, Pham et al. discloses a system for integrating application programs including a first and second code translators for converting data into a common formatting convention and for converting data from common formatting convention to target software formatting convention, wherein the first code translator including data field detection and definition module. Pham et al., col. 16, lines 34-56, col. 17, line 49 to col. 20, line 16, col. 10, line 33 to col. 11, line 50. It would have been obvious to one having ordinary skill in the art at the time of the invention to include first and second (i.e. marshalling and unmarshalling) code translators into the computer network disclosed by Edelson with the motivation of improving interprocess-communication between the computers in the network due to data incompatibilities. Pham et al., col. 1, lines 15-22.

(E) As per claims 2, 26, Pham et al. teaches the second code translator for converting data from common formatting convention to target software formatting convention. Pham et al., col. 16, lines 34-56, col. 17, line 49 to col. 20, line 16, col. 10, line 33 to col. 11, line 50.

(F) As per claims 3, 18, 37, 40, Pham et al. teaches that the transfer of data to applications in a new machine, and a request manger for performing request actions that can be sending a message or a file to the destination node on col. 5, lines 58-63,

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col. 6, lines 16-20, col. 9, lines 1-4, lines 32-62. It is readily apparent that transmitter is included to transfer/send data or files.

(G) As per claims 5,6, application program for prescription analyzing and alert signal generating is disclosed in Edelson et al. on col. 30, lines 44-50, col. 30, line 60 to col. 31 line 6.

(H) As per claims 7, 22, 32, code identification for determining formatting convention is disclosed on col. 15, line 43 to col. 16, line 56, col. 17, line 4 to col. 19, line 25, Figs 4-6.

(I) As per claim 8, 30, Pham et al. teaches data field detector and definition module on col. col. 10, line 33 to col. 11, line 50.

(J) As per claim 9,15, 29, 39, computer network, first code translator for the application program located on a first computer, application programs on different second computer are disclosed on col. 5, lines 20-68, col. 7, lines 4-30.

(K) As per claims 10-12, 24, 33, 43, Edelson et al discloses application programs for prescription programs, drug formulary, drug interaction, accounting programs, patient /medical record keeping, insurer, claims processing program, databases on col. 4, lines 20 to col. 6, line 28, col. 12, lines 20-65, col. 14, lines 1-68, col. 15, lines 13-25, lines 35-40, col. 16, lines 10-25, col. 21, line 49 to col. 24, line 60, col.52, lines 18-48.

(L) As per claim 13, 23, 34, integrity check module is disclosed on col. 11, lines 46-51 of Edelson et al.

(M) As per claims 16, 17, 27, 28, 36, 38, Pham teaches that second code translator (i.e., unmarshalling module) can reside in a first or a second computer in the network.

Pham et al. col. 17, lines 50-55.

(N) As per claims 20, 21, 41, 42, the data processing module for prescription analyzer and drug interaction is disclosed in Edelson et al. col. on col. 30, lines 44-50, col. 30, line 60 to col. 31 line 6.

(O) As per claim 31, Edelson et al. teaches the medical record database, the drug interaction database and the determination of possible drug interaction on col. 12, lines 20-68, col. 20 lines 1-30, col 4, lines 60 to col. 6, line 28, col. 45, lines 15-68, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38, col. 30, lines 61-65, col. 31, lines 38-43, col. 32, lines 48-60, col. 30, lines 44-50, col. 30, line 64 to col. 31, line 38.

6. Claims 4, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al. and Pham et al. as applied to claims 3, 18 above, and further in view of Heilman et al. (4885677)

(A) As per claims 4, 19, Edelson et al. and Pham et al. fail to teach a batch and sequence generator. This, however, is well known as evidenced by Heilman et al. Heilman et al, col. 2, lines 25-35, col. 8, lines 20-45. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a batch and sequence generator with the motivation of conforming to standard practice. Heilman et al., col. 1, lines 23-26.

Conclusion

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. " Prescription management data" (5845255), " Patient specific drug information" (6317719); 'Medical records and order entry system" (5823948), " Method for translation of program" (5872978);" Inter-Application system and method" (6742181); "System for exchanging data processing capabilities" (5621894);" Networked service request and fulfillment system" (5995939); " The development of a client application for the collaborative social and medical services system", Moore D M et al. , " Proceedings / the.... Symposium on Computer Applications in Medical Care (United States) 1994, p 609-13, ISSN 0195-4210 Journal Code: 8113685, Dialog File 155, Acc. no. 10248626.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 703-305-5874. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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12/16/04


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